PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of: Neal Osborn et al.   NOV 1 2 2004

Serial: 09/773,061   Group Art Unit: 2682 Technology Center 2600

Filed: January 30, 2001   Examiner: Yuwen Pan

For: METHOD AND APPARATUS FOR SELECTIVE AND
              AUTOMATIC TWO-WAY BEAMING OF RELATED
              INFORMATION TO AND FROM PERSONAL INFORMATION
              MANAGEMENT SYSTEMS

REMARKS

Honorable Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the non-final Office Action mailed August 25, 2004 in the

above captioned case, Applicants respectfully request the Examiner to consider

the following remarks.

<u>Examiner Interview Summary</u>

On July 29, 2004, Examiners Yuwen Pan and Charles Craver conducted an Examiner Interview via telephone with Neal Osborn, the primary inventor of the above captioned case, and Anthony Murabito, Applicants' representative. The claims, status of prosecution and the Hild reference were discussed. A previously uncited reference, Bell, was introduced.

Applicants' arguments were found persuasive and the Examiners agreed that the rejections of the previous Official Action would be reviewed and potentially withdrawn.

Applicants thank the Examiners for the Interview.

<u>REMARKS</u>

Claims remaining in the present patent application are Claims 1 – 20.

<u>35 U.S.C. § 103(a) Rejections</u>

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bell (US# 6,600,902 B1, "Bell") in view of McGaughey, III et al. (US 4,977,520, "McGaughey"). Applicants have carefully reviewed the cited references and respectfully assert that embodiments of the present invention as recited in Claims 1-20 are not rendered obvious by Bell in view of McGaughey.

Applicants respectfully assert that Bell <u>teaches</u> <u>away</u> from embodiments in accordance with the present invention as recited in Claims 1-20. Bell teaches, "the application <u>automatically</u> performs the <u>complete</u> session." (column 7, lines 5-6, emphasis added). This is in direct opposition to embodiments in accordance with the present invention as recited in Claims 1-20 that require user interaction and non-automatic actions depending upon such user interactions within an information exchange.

For example, Claim 1 recites, in part, "b) said second electronic device receiving said first information" and "in response to step b), said second electronic device automatically displaying a message indicating a user selection." Another element of Claim 1 recites, sending information from the second device to the first device "responsive to said user selection." Applicants respectfully assert that Bell's teaching, "the application automatically performs the complete session," does not permit the operations required by Claim 1. More particularly, Bell's

method that "<u>automatically</u> performs the <u>complete</u> session" does not permit a "user selection." Further, Bell's method does not permit an action "responsive to said user selection."

For this reason, Applicants respectfully assert that Claims 1-20 overcome the rejections of record, and respectfully solicit allowance of these Claims.

Further with respect to Independent Claims 1, 8 and 14, Applicants respectfully assert that Bell in view of McGaughey does not teach, disclose or suggest the claim limitations of "responsive to said user selection, said second electronic device automatically communicating second information to said first electronic device wherein said second information is of said information category type" as recited by Claim 1 or the claim limitations of "responsive to said user selection, said second electronic device... automatically communicating a second electronic business card to said first electronic device" as recited by Claims 8 and 14.

The rejection acknowledges that Bell does <u>not</u> teach, suggest or disclose the limitations of "second electronic device automatically displaying a message indicating a user selection." Consequently, Bell <u>cannot</u> teach, suggest or disclose any action responsive to such non-existent user selection, such as the limitation of automatically communicating a second message of the same type, as recited in the instant claims.

McGaughey does not correct this deficiency. McGaughey teaches responsive to a user selection (accepting a meeting invitation) to "reply back to

the meeting originator" (column 4 line 42). Such a reply message as taught by McGaughey is not "second information… of said information category type" as recited by Claims 1, 8 and 14.

Thus, neither Bell nor McGaughey, alone or in combination, teach, suggest or disclose all limitations of Claims 1, 8 and 14. Consequently, Applicants respectfully assert that Claims 1, 8 and 14 overcome the rejections of record, and respectfully solicit allowance of these Claims.

Claims 2-7 depend from Claim 1. Applicants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and respectfully solicit allowance of these Claims.

Claims 9-13 depend from Claim 8. Applicants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and respectfully solicit allowance of these Claims.

Claims 15-20 depend from Claim 14. Applicants respectfully assert that these Claims overcome the rejections of record as they depend from an allowable base claim, and respectfully solicit allowance of these Claims.

In addition with respect to Claim 7, Applicants respectfully assert that Bell in view of McGaughey do not teach, disclose or suggest the limitations of "wherein said information is data base files" as recited by Claim 7. Applicants have reviewed the cited portion of Bell (figure 2 item 27). Applicants find Bell to describe item 27 as "a computer program implementing (an embodiment)

according to the invention." Applicants respectfully assert that Bell's "computer program" is not a "data base file" as claimed in accordance with conventional usage of the terms.

For this additional reason, Applicants respectfully assert that Claim 7 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Assuming, *arguendo*, that Bell item 27 does comprise a "data base file" as recited in Claim 7, Applicants respectfully assert that Bell is silent as to transferring item 27 between electronic devices as further recited by Claim 7.

For this yet additional reason, Applicants respectfully assert that Claim 7 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

With respect to Claims 13 and 19, Applicants respectfully assert that Bell in view of McGaughey do not teach, disclose or suggest the claim limitations of "wherein step c) comprises the step of said second electronic device allowing a user to select between: 1) accepting said first electronic business card; 2) rejecting said first electronic business card; and 3) accepting said first electronic business card and automatically transmitting said second electronic business card" as recited by Claims 13 and 19.

Applicants respectfully point out regarding the rejection of Claims 13 and 19, that the rejection has previously acknowledged that the recited step c), "said

second electronic device automatically displaying a message indicating a user selection," is <u>not</u> taught by Bell. Applicants do not understand how a user can select between options if there is no message indicating a user selection. The Examiner is requested to clarify this rejection of Claims 13 and 19 or to withdraw the rejection.

For this additional reason, Applicants respectfully assert that Claims 13 and 19 overcome the rejections of record, and respectfully solicit allowance of these Claims.

With respect to Claim 20, Applicants respectfully assert that Bell in view of McGaughey does not teach, disclose or suggest the claim limitations of "said display screen is a liquid crystal display screen" as recited by Claim 20. Applicants respectfully assert that Bell does not describe "display 28" as a liquid crystal display screen. Further, Applicants respectfully assert that both Bell and McGaughey are silent as to liquid crystal display technology.

For this additional reason, Applicants respectfully assert that Claim 20 overcomes the rejections of record, and respectfully solicit allowance of these Claims.

CONCLUSION

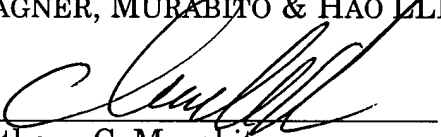Claims remaining in the present patent application are Claims 1 – 20.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 23-0085.

Date: 11/5/2004

Respectfully submitted,

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